

REMARKS

Upon entry of the amendments, claims 14, 16-18, 21, 25-29, 33, and 34 will be pending in the application. No claim fees are believed to be due as a result of these amendments.

Applicants note that the Examiner has withdrawn the prior art rejections and has indicated that several of the objections and 112 rejections have been withdrawn. Applicants provide the followings comments to the maintained and new rejections set forth in the Office Action of March 10, 2004.

Objections to the Specification

Applicants note that the Examiner has maintained the objection to the Abstract. The Abstract has been amended to identify the source species. As such, Applicants request the withdrawal of the objection.

Claim Rejections – 35 U.S.C. § 112 (second paragraph)

The rejections of claims 14, 16-18, 21, and 25-29 as indefinite have been maintained by the Examiner. In response, Applicants have amended the claims to address the Examiner's rejections. Applicants respectfully submit that the amended claims comply with the second paragraph of 35 U.S.C. § 112.

Applicants also note that the Examiner has indicated that the rejection of claim 14 would be withdrawn if the "activity" phrase would be deleted. As such, new claim 33 is similar to prior pending claim 14 with a deletion of the "activity" phrase.

Regarding the new rejections of claims 25, 26, and 28, Applicants respectfully submit that the claims have been amended to obviate the rejections. In response to these rejections,

Applicants have removed the gene names as suggested by the Examiner. Moreover, the phrases “a protein for lysine export” and “zwa2 protein” have been deleted from the claims. However, with respect to the “zwa1 protein,” Applicants note that the terminology “zwa1 protein” would be readily understood by those of ordinary skill in the art. For example, U.S. Pat. No. 6,632,644 describes the “zwa1 protein” of coryneform bacteria. Further, the specification refers to DE: 19959328.0 where the zwa1 protein is described. Since this document has been incorporated by reference into the present specification, the present specification adequately describes the “zwa1 protein.” Those of ordinary skill in the art would readily understand what is intended by the terminology “zwa1 protein.” Hence, withdrawal of this rejection is respectfully requested.

Regarding the rejection of claim 28, Applicants have amended the claim to clarify the subject matter of the invention. Applicants assert that the rejection should be withdrawn.

Claim Rejections – 35 U.S.C. § 112 (first paragraph)

The rejections of claims 25, 28 and 29 have been maintained because the claims allegedly failing to meet the written description requirement or lack of an enabling deposit.

In response, Applicants have amended claim 25 to address the Examiner’s concerns regarding the written description requirement.

Regarding claims 28 and 29, Applicants have amended the specification to provide the full address of the depository to provide an enabling deposit.

Applicants respectfully submit that the claims comply with the written description requirement of 35 U.S.C. § 112.

Applicants also note the Examiner’s new rejection of claim 25, which relies on the Eli Lilly case. Although this case is generally applicable to small molecules, there are other cases

that indicate functional language is acceptable in certain situations. However, Applicants have amended this claim and believe that it is in compliance with the requirements of 35 U.S.C. 112.

Likewise, regarding the rejection of claims 25 and 26 set forth in paragraph 24 of the Office Action, Applicants have amended the claims to obviate the rejection. Applicants also reiterate that the “zwa1 protein” language should be acceptable based upon the incorporation by reference of the German application.

Regarding the rejection of claims 14, 16-18, 21, and 25-29, Applicants believe that the rejection should be withdrawn because of the claim amendments.

Applicants note that new claim 33 is similar to prior pending claim 14. However, Applicants do not believe that the rejection regarding “overexpression” is pertinent. The claim and specification sufficiently enables one skilled in the art to ferment the coryneform bacteria which produce a desired L-amino acid comprising an overexpressed polynucleotide sigC. The disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. The Examiner has acknowledged that the specification references several means of overexpression and that these means are known in the art. The Examiner, however, believes that not all of these means would be applicable to producing a desired L-amino acid comprising an overexpressed polynucleotide sigC. However, it is not necessary for Applicants to detail every method of overexpressing polynucleotide sigC. It is clear that one skilled in the art would know how to overexpress. Further, the fact that some experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation.

Regarding the rejection set forth in paragraph 26, Applicants believe that the claim amendments and statements regarding "zwa1" are sufficient to overcome the rejection.

New Claims

Applicants believe that new claims 33 and 34 are allowable in view of the cited prior art. Applicants also believe that these claims comply with the requirements of 35 U.S.C 112.

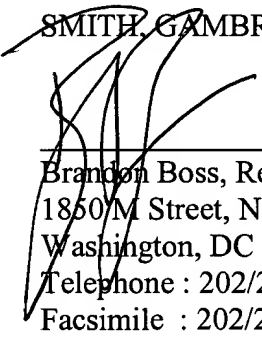
CONCLUSION

Applicants request allowance of the application. If any additional fees are due in connection with the filing of this response, please charge the fees to Deposit Account No. 02-4300. Any overpayment can be credited to Deposit Account No. 02-4300.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

Date : June 10, 2004



Brandon Boss, Reg. No. 46,567*
1850 M Street, NW – Suite 800
Washington, DC 20036
Telephone : 202/263-4300
Facsimile : 202/263-4329

* Practice is limited to matters and proceeding before federal courts and agencies.